REMARKS

Claims 1, 8, 14-17, 19-30, 32, and 33 were pending. No claims have been added or cancelled. Claims 1, 8, and 32 have been amended. No new subject matter has been added. Therefore claims 1, 8, 14-17, 19-30, 32, and 33 remain pending in the application.

Claim Rejections

Claims 1, 8, 14, 16, 17, 21, 22, 25, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,734,589 (hereinafter "Kostreski") in view of Gordon et al. (US 6,208,335, hereinafter "Gordon"). Claims 15, 23, 24, and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kostreski in view of Gordon and further in view of U.S. Patent 5,903,262 (hereinafter "Ichihashi"). Claims 19 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kostreski in view of Gordon and further in view of U.S. Patent Publication 2004/0221307 (hereinafter "Arai"). Claims 20, 28, and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kostreski in view of Gordon and further in view of Strauss et al. (US 5,790,173, hereinafter "Strauss"). Finally, claims 32 and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kostreski in view of Gordon and further in view of Terakado et al. (US 6,311,329). Applicant respectfully traverses the above rejections and requests reconsideration in view of the following discussion.

In paragraph 2 of the present Office Action, in response to Applicant's previous arguments regarding a built-in banner as recited in claim 1, the Examiner suggests

> "the features upon which applicant relies (i.e., "… a built-in application, called Banner stored in the decoder in order to allow a user to navigate or surf through all available services. This built–in software presents all services to the viewer and enables the channel changing process. In other words, the Banner handles all channel changing processes inside the decoder.") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 UPQ2d 1057 (Fed. Cir. 1993)."

The Examiner further suggests:

> "The applicant is not explicitly claiming a built-in banner, but something that is "termed" a built-in banner corresponding to a built-in application. The way it is claimed merely, states a second application that is called or named a built-in banner that corresponds to a built-in application, and does not explicitly further limit and explicitly define what constitutes a built-in banner. Therefore, a component that corresponds to a built-in application such as the part of software in Kostreski that handles presentation of services meets the claimed limitations."

While Applicant does not agree with the Examiner's arguments, Applicant has nevertheless amended claim 1 to clarify what is meant by a built-in banner in order to facilitate speedy prosecution of the present application. Claim 1 now recites, in part:

> "A method for controlling navigation events between a plurality of services and/or channels in an interactive broadcasting system including at least one interactive decoder, said system broadcasting applications to be received by said decoder, applications utilized by the decoder being categorised into at least two types of applications including a first type termed a surfer application for controlling said navigation and having knowledge of said services, and a second type termed a built-in banner, the method comprising:
> ...
> routing said navigation event to a built-in banner, in response to determining no surfer application is available and the decoder is not under control of a surfer application;
> wherein the built-in banner comprises an application that is built-in to the decoder and is configured to:
> control navigation events; and
> present said services to a user."

It is noted that the language in the preamble, "a second type termed a built-in banner corresponding to a built-in application for presenting services" has been amended to recite "a second type termed a built-in banner." In addition, the claim now explicitly recites a built in banner as well as additional distinguishing aspects of a built-in banner. Applicant submits it is clear from the above that a built-in banner is a built in application, and that it handles navigation events (e.g. channel changing) and presentation of services for available services.

In contrast, Kostreski suggests that when it is determined that no surfer application is available, rather than using a built-in banner, a new surfer application is sought. In the present Office Action, the Examiner suggests Kostreski teaches these features at col. 27, lines 26-34. However, Kostreski merely teaches a DET may have some built-in functionality. However, there is no disclosure of routing to an application that is built-in to the decoder and is configured to: control navigation events; and present said services to a user (i.e., to a built-in banner, as recited). Furthermore, Kostreski suggests that when it is determined that no surfer application is available, rather than using a built-in banner, a new surfer application is sought. More specifically, Kostreski teaches:

> "If the navigation program is stored in the DET, the pressing of the "GUIDE" button begins execution of the guide program, which directs the DET to download any necessary data, and thereafter provides a menu for the user. If the navigation program is not stored in the DET, then the pressing of the "GUIDE" button initiates a routine in the operating system to go to the appropriate control channel (e.g., channel 01, timeslot 0) to access, capture and execute the navigation software.
>
> Once at least the program mapping portion of the software and/or data are stored in DET memory, the DET uses that information to select program services in response to user inputs." (Kostreski, col. 27, lines 22-34, emphasis added).

What should be appreciated from the above is that in contrast to the recited "routing said navigation event to the built-in banner, in response to determining no surfer application is available," in the absence of an already loaded navigation program, Kostreski's system goes to the appropriate control channel to access, capture, and execute navigation software. Therefore, not only does Kostreski not disclose a built-in banner as recited, Kostreski neither teaches nor suggests "routing said navigation event to the built-in banner, in response to determining no surfer application is available and the decoder is not under control of a surfer application," as is recited in claim 1. As for Terakado, the Examiner suggests Terakado teaches an electronic program guide stored on a CD-ROM that is read by the client and outputs an Electronic Program Guide for presenting

available programs. However, Terakado's CD-ROM-based EPG is not equivalent to the recite built-in banner since it does not comprise an application that is built-in to the decoder.

For at least the above reasons, Applicant submits claim 1 is patentably distinguishable from the cited art, taken either singly or in combination. As claim 8 has been amended in a manner similar to that of claim 1, claim 8 is patentably distinguishable from the cited art for similar reasons. The dependent claims are likewise patentably distinguishable for at least the above reasons.

In addition, claim 32 recites

> "The method of claim 1 wherein the built-in banner is configured to present services without use of a downloaded surfer application."

In section 8 of the present Office Action, the Examiner admits Kostreski and Gordon do not explicitly teach the built-in banner is configured to present services without use of a downloaded surfer application. Instead, the Examiner suggests Terakado teaches these features. However, the amendments to claim 1, upon which claim 32 depends, clarify that the built-in banner is a built-in application and is distinguished from Terakado's CD-ROM-based EPG. Therefore, even though Terakado's CD-ROM-based EPG does not use a downloaded surfer application, it is not a built-in banner. Further, even assuming for argument's sake that Kostreski and Gordon teach a combination of software that is built-in and controls navigation and presents services, it does not perform these tasks without use of a downloaded surfer application. Accordingly, Applicant finds no teaching or suggestion in the cited art of "wherein the built-in banner is configured to present services without use of a downloaded surfer application," as is recited in claim 32. For at least these additional reasons, claim 32 is patentably distinguishable from the cited art, taken either singly or in combination, as is claim 33 for similar reasons.

In view of the above, Applicant believes all claims to be in condition for allowance. If the examiner believes a telephone interview would facilitate allowance of the present matter, the below signed representative requests such an interview.

CONCLUSION

Applicant submits the application is in condition for allowance, and notice to that effect is respectfully requested.

If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above-referenced application from becoming abandoned, Applicant(s) hereby petition for such an extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5266-05900/RDR.

Respectfully submitted,

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